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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,763	10/17/2001	William Sanford	00725.0361-US-01	8838
22865	7590	03/18/2008		
Altera Law Group, LLC 220 S 6 St Suite 1700 Minneapolis, MN 55402			EXAMINER CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1794	
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			03/18/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/981,763

Applicant(s)

SANFORD, WILLIAM

Examiner

Victor S. Chang

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-45 is/are pending in the application.
- 4a) Of the above claim(s) 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Introduction

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered. Claim 32 has been amended. New claims 44 and 45 have been entered. Claims 32-45 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Election/Restrictions

4. Newly submitted claim 45 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions of an alignable label system (claims 32-44) and a method of aligning a label (claim 45) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the

instant case the product as claimed can be used in a materially different process of using that product, such as hand applying non-aligned labels.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 45 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims 32-44 are active.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

6. Claims 32-38 and 40-44 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter, as evidenced by MacWilliams et al. [US 6385860].

MacWilliams' invention relates to an alignable label system 100 comprising a label sheet 130 having a central split line 111, the label sheet having a perimeter line separating a label 101 from a second portion (outside the perimeter). The system further comprises a backing member 102 applied to the label and having a split line 111. An alignment section on the second portion is separable from the label and includes an edge to conform to the edge of a folder [abstract].

For claim 32, regarding the use language “wherein when one portion ...affixed to the folder”, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight.

For claim 33, Fig. 2 illustrates that the curved edge 116a is proximate at least one edge of the label.

For claim 34, MacWilliams teaches a method of aligning and applying a label to the edge of a folder comprising the steps of removing a portion of the backing member from the label, aligning the alignment section to the edge of the folder, applying the label, peeling of the remaining backing member and folding the label over the edge [col. 4, ll. 38-65].

For claim 35, the top side of the label is adapted for printing [col. 7, ll. 1].

For claims 36-37, Figs. 1 and 2 illustrates that the curved edge is "S"-shaped.

For claims 38 and 44, since statements of intended use do not serve to distinguish structure over the prior art, it has not been given any patentable weight.

For claim 40, the label is adhesive [col. 2, ll. 36-37] on the surface contacting the backing member.

For claim 41, Fig. 1 shows a plurality of labels 110, 112, 113 with die-cut lines therebetween.

For claim 42, the die-cuts 116a and 117 separate the second portion into first and second parts, and wherein the label split lines and at least in part, follows a curve which is substantially the same the folder's curved edge as shown by line 116a in Fig. 1.

For claim 43, MacWilliams teaches the step of removing the backing sheet along the split line [col. 4, ll. 38-65].

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacWilliams et al. [US 6385860].

MacWilliams lacks a teaching that the curved portion on the second portion is spaced from the label. However, MacWilliams illustrates in Fig. 1 that a curved portion 116a is perforated and would have tie portions between the cut portions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to space the label from the curved portion, and the tie portions would provide for the spacing of the curved portion from the label.

Response to Arguments

8. Applicant argues at Remarks page 7 that since the cited prior art was assigned at filing to the same assignee as the present invention, the 102(e) based rejections are overcome under the 103(c). However, since the inventor is not a co-inventor of the prior art reference, the rejections are maintained under 35 USC 102(f).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794